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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/848,695	05/03/2001	Rigby Jacobs Heusinkveld	10007179-1	5737

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HEWLETT-PACKARD COMPANY
Intellectual Property Administration
P.O. Box 272400
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EXAMINER

RUHL, DENNIS WILLIAM

ART UNIT	PAPER NUMBER
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3629

DATE MAILED: 03/11/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

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Office Action Summary

Application No.

09/848,695

Applicant(s)

HEUSINKVELD, RIGBY JACOBS

Examiner

Dennis Ruhl

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 01 December 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-25 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-25 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Applicant's response and amendment of 12/1/04 has been entered and considered. The examiner will address applicant's remarks at the end of this office action.

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 1-8,24,25, are rejected under 35 U.S.C. 102(b) as being anticipated by Hirst et al. (5930553).

For claims 1,2, Hirst discloses a warranty system as claimed. The consumable item is 18 and has an interface to allow communication with the device (the printer/computer the consumable is used in). See column 2, lines 37-39 and lines 43-47. The memory is 19 and is disclosed as storing the kind of information as claimed. Applicant should take notice that the type of data being stored is considered to be non-functional descriptive material that does not serve as a limitation, so even if Hirst did not disclose the claimed type of data, memory 19 would still satisfy what is claimed and is fully capable of storing any kind of data. The consumable item 18 is disclosed as having computer instructions that obtain various types of data that is to be stored on the memory 19. Warranty information such as installation date, and use data such as the

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number of prints can be obtained and stored in the memory 19. See column 3, lines 16-33.

For claim 3, the computer executable instructions to generate an image of warranty requirements is interpreted to be the printer driver software that allows printing. The fact that the claim is reciting that the printed image is warranty requirements and "when completed" is taken as the intended use of the computer instructions. In the current article claims it does not matter what is being printed or when the printing is done. This defines no further structure to the article itself but is more of an intended use recitation.

For claim 4, Hirst inherently discloses a processor. See column 4, lines 39-44 where it is disclosed that the consumable 18 has a sensor that detects toner level and that can send out a low toner signal when such a condition is detected. This method of sensing data and sending out a signal inherently requires a processor. You need a processor to perform these steps. The processor inherently has the ability to execute instructions as claimed, especially in view of the fact that it is executing instructions of sensing data and if toner is low, generating a signal.

For claim 5, a user can interact with the system using their computer. When a person prints a print job, this fact is saved in the memory of the consumable item. This is interaction as claimed.

For claim 6, Hirst discloses a computer 20 as claimed.

For claims 7,8, Hirst discloses computer instructions to allow communication of data over a communication network. See column 6, lines 17-20 where it is disclosed

that some of the software can be software that provides an Internet or BBS link to allow communication (transfer of data). This satisfies what is claimed.

For claim 24, Hirst discloses that calibration data can be stored on the consumable (that is used to calibrate the device) as well as various type of software upgrades for the print drivers, host computer, etc.. Calibration is the same as running a diagnostic test, it is checking the device and resetting some value or variable if not correct. Hirst discloses that the memory 19 stores software as claimed and included in the scope of the disclosure is that the software upgrades include diagnostic upgrades (software for the device, where it is disclosed that the device does diagnostic testing).

For claim 25, the examiner considers the second memory to be either memory in the device (printer) or the memory of the host computer. Both memories are capable of and are disclosed as storing the claimed kind of data.

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 9-23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hirst et al. (5930553) in view of Siegel et al. (2003/0069750).

For claims 9,12,17-19,21,22, Hirst discloses that in the technology of image forming equipment (and specifically with respect to the consumables used in the equipment) it is difficult for manufacturers to obtain use data and other data of interest

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directly from the consumer. Manufacturers try to get customers to fill out and mail back survey cards that identify who they are and provide other useful data to the manufacturer but participation rates are very low. The gathering of data and being able to contact the buyer of the product directly is very important to the manufacturers. If the manufacturer cannot contact the buyer directly, they then cannot contact the buyer for recall notices, product sales, warranty information, etc. See the Background of the Invention section where this is discussed in detail. Hirst also discloses that it is desirable for the manufacturer to be able to have software upgrades available in the memory of the consumable for uploading to the host device. This allows bugs and problems known to the manufacturer to be able to be fixed easily and effortlessly. Hirst also discloses in column 6, that an Internet connection may be used for the transfer of data and for software downloads.

Hirst discloses a consumable such as a toner cartridge that has a memory 19 included in the consumable for the storage of data and for the transfer of computer code from the consumable to the printer (or host device 10). The step of monitoring use of the consumable item and the storing of use data on the memory is disclosed is Hirst. See column 3, lines 16-33. The step of obtaining warranty information stored on the memory and obtaining stored use data is satisfied by the fact that this is the reason the consumable has a memory. The memory is there so that the manufacturer can get the use data and other relevant data of interest. The data is stored in memory so that the data can be obtained in the future. Hirst discloses the claimed invention except for the

step of prompting a user for warranty relevant data and completing warranty requirements.

Siegel et al. discloses that warranty cards are often not filled out by the consumer and manufacturers are deprived of useful data, sales promotion abilities, etc.. Siegel recognizes the same problem Hirst discloses with respect the filling out of survey cards, etc.. Siegel discloses that one solution for this problem in the area of software (or computer products) is that upon installation on a computer the user is immediately prompted for some various information that is sent over the Internet to a manufacturer and this results in the product being registered. The solution to the problem of low participation rates of returning registration cards/warranty cards is to have an automated registration process. It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the consumable of Hirst with software that automatically prompts the user for some information (such as a name) upon installation of the consumable to register the product and buyer, with the information being sent to the manufacturer over the Internet. This then results in product registration, which is considered to satisfy the step of completing warranty requirements. The fact that the product has been registered allows for substantiation of a warranty claim in the event a claim is made.

With respect to claims 10,22, it is considered inherent that a user interface of some kind is going to be generated during the step of prompting the user for information. You cannot prompt a user for information with no interface to allow the communication of what is requested.

For claims 11,15, Hirst does not disclose what is claimed. It is a well-known fact that many products come with warranty information in printed form that notifies the purchaser of the terms and conditions of the warranty and instructions on how to go about registering the product. It is considered obvious to one of ordinary skill in the art at the time the invention was made to print the warranty information for the buyer or save the information in an external device so that the buyer has a written record/backup copy of the warranty and registration of the product that was just completed. Hard copies and backup copies of important documents (such as a warranty registration information) saved on computers are especially important in the event the computer hard drive fails and the electronic information of the warranty is lost.

For claims 13,23, Hirst discloses that calibration data can be stored on the consumable (that is used to calibrate the device) as well as various type of software upgrades for print drivers, host computer, etc.. Calibration is the same as running a diagnostic test, it is checking the device and resetting some value or variable if not correct. Hirst discloses that the memory 19 stores software as claimed.

For claims 14, Hirst does not disclose what is claimed. It is considered obvious to one of ordinary skill in the art at the time the invention was made to compare diagnostic information (calibration data) with warranty data (calibration benchmarks or standards) in the event the buyer attempts to return the product. If the calibration data indicates that the consumable is calibrated correctly the manufacturer may not honor a replacement (covered under a warranty) when the alleged problem is improper calibration.

For claim 16, it necessarily follows from the 103 rejection that upon the installation of a new consumable, the new consumable will operate as did the original one in the sense that it will prompt the user for information, store use related data in the memory of the new consumable, etc.. This data may then be used in warranty inquiries (is warranty relevant data).

For claim 20, the means for forming the image is the toner or ink in the consumable. The ink or toner is what forms the image.

6. Applicant's arguments filed 12/1/04 have been fully considered but they are not persuasive.

Applicant has attempted to remove the Hirst reference as available prior art by making a statement that the instant application was commonly owned (with Hirst) at the time of invention of the instant application. For the 103 rejection of record, this is not a persuasive argument because Hirst is not a 102(e) type of reference and cannot be disqualified as applicant has attempted to do. Only a 102(e) type of reference can be disqualified from a 35 USC 103 (c) rejection. Hirst is a 102(b) type of reference. Applicant is referred to MPEP 706.02 where this is discussed. Specifically see 706.02(I)(1)-706.02(I)(3). Because applicant has amended some of the claims to now be rejected under 35 USC 102(b), the attempt to disqualify Hirst would not apply to a any claims rejected under 102(b) because any disqualification would only be applicable to a 103 rejection.

No other argument has been made for patentability so the rejections are deemed proper.

7. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dennis Ruhl whose telephone number is 571-272-6808. The examiner can normally be reached on Monday through Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss can be reached on 571-272-6812. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

A handwritten signature in black ink, appearing to read 'D. Ruhl', with a long horizontal flourish extending to the right.

DENNIS RUHL
PRIMARY EXAMINER